

REMARKS

Claims 1-27 are pending in the above-referenced patent application. Claims 1-20 have been amended, and claims 21-27 have been added. It is noted that these claims were not amended to overcome the rejections and objections, or in light of the cited references. Rather, the claims were amended to more clearly delineate intended subject matter. Furthermore, it is believed that these amendments do not narrow claim scope. Rather, in some cases, the claims are even broadened. Therefore, no prosecution history estoppel should result from these claim amendments. Additionally, it is respectfully submitted that adequate support may be found in the specification for new claims 21-27. For example, adequate support may be found at least from page 7, line 9 through page 12, line 11 and FIGs. 2A-4.

In the Office Action, dated December 30, 2005, the Examiner objected to the specification for informalities. Assignee has amended the specification in accordance with Examiner's suggestions, and it is respectfully submitted that the amendments to the specification obviate the objections. Therefore, it is respectfully requested that the Examiner withdraw this objection to the specification.

The Examiner has additionally objected to the specification for not being enabling; and rejected claims 1-19 under 35 U.S.C 112, first paragraph, as failing to comply with the enablement requirement. These objections and rejections are respectfully traversed.

It is respectfully submitted that the specification provides adequate support for the claims, as amended, and therefore is sufficiently enabling. Likewise, it is respectfully submitted that claims 1-19, as amended, are adequately enabled by the specification. It is respectfully submitted that in light of the amendments made to claims 1-19, in which a portion of claim 1 noted by the Examiner as not having support in the specification, "removing a portion of the framed area beyond the confined area to transform the framed area into the scan area" has

been substantially deleted in order to more clearly delineate intended subject matter, the objection to the specification, as well as the rejection of claims 1-19 for failing to comply with the enablement requirement are moot. It is respectfully submitted that one skilled in the relevant art would be able to refer at least to page 7, line 14 through page 9, line 7 and Figure 2A to make and/or use at least one embodiment of the claims, as amended. Therefore, it is respectfully requested that the Examiner withdraw these objections and rejections.

Additionally, the Examiner rejected claims 1, 13 and 20 under 35 U.S.C. 103(a) as being unpatentable over so-called Applicant's admitted prior art in view of "well known art". This rejection is respectfully traversed.

It is respectfully submitted that the Examiner has provided no reference to support any assertion that "well known art" describes at least the above-noted limitations. Additionally, the Examiner states, "The examiner took Official Notice of the fact that such step [removing a portion of said framed area beyond said confined area to transform said area into said scan area] is well known in the art of image processing and editing using a displayed preview image." This Official Notice is respectfully traversed. It is respectfully submitted that the limitation "removing a portion of said framed area beyond said confined area to transform said area into said scan area" is not well-known in the relevant art. Additionally, it is respectfully submitted that the manner by which the Examiner is taking Official Notice is inappropriate. As stated in Manual of Patent Examining Procedures, 8th Ed. Oct. 2005 Revision, Section 2144.03 (Aug. 2001), "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." It is respectfully submitted that this standard applies here. Additionally, again quoting from MPEP 2144.03, "If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her

conclusion of common knowledge. See Soli, 317 F.2d at 946, 37 USPQ at 801; Chevenard, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." Assignee respectfully requests that the Examiner either provide documentary evidence of the assertion that this limitation is well known in addition to providing the explicit basis on which the Examiner regards the matter as subject to Official Notice, in accordance with MPEP 2144.03, or withdraw the rejection to claims 1, 13 and 20.

Additionally, although assignee respectfully submits that claims 1, 13 and 20 are not rendered obvious by over so-called Applicant's admitted prior art in view of "well known art", it is further noted that in order to establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that so-called Applicant's admitted prior art in view of "well known art" does not meet these criteria. For example, so-called Applicant's admitted prior art in view of "well known art" would still not teach or suggest all the claim limitations.

For example, it is respectfully submitted that so-called Applicant's admitted prior art, whether viewed alone or in combination with "well known art", still does not show or describe at least "scanning an original comprising one or more objects; generating a preview window of the scanned original, wherein the preview window includes a profile of at least one of said one or more objects, and wherein said profile defines a confined area of the preview window; receiving a selection of at least one profile included in said preview window; determining a scan area based at least in part on said selection; and scanning said scan area.", as recited in claim 1, as amended. Quoting from the "Description of the Prior Art" section of the present application, "The conventional scanning method comprises steps of arranging an original on a scanner to scan the entire original (step 11), displaying a preview window of the original (step 12), selecting a scan area from the preview window by user (step 13), and scanning a portion of the original corresponding to the scan area (step 14)." As indicated by the excerpt of the "Description of the Prior Art" section, there is no description of at least "generating a preview window of the scanned original, wherein the preview window includes a profile of at least one of said one or more objects, and wherein said profile defines a confined area of the preview window; receiving a selection of at least one profile included in said preview window; determining a scan area based at least in part on said selection", as recited in claim 1, as amended. Therefore, a successful showing of a *prima facie* case of obviousness has not been made.

Assignee respectfully submits that because a *prima facie* case of obviousness has not been established, the rejected claims are in a condition for allowance. It is noted that many other bases for traversing the rejection could be provided, but Assignee believes that this ground is sufficient. It is respectfully requested that the Examiner withdraw his rejections of claims 1, 13 and 20.

Additionally, new claims 21-27 are in a condition for allowance for the same and/or similar reasons as presented above.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

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